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09/208,097	11/16/1998	JOHN S. HENDRICKS	5213	7677

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ALDO NOTO  
DORSEY & WHITNEY  
1001 PENNSYLVANIA AVENUE NW  
SUITE 300  
WASHINGTON, DC 20004

EXAMINER

KOENIG, ANDREW Y

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 04/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/208,097

Applicant(s)

HENDRICKS ET AL.

Examiner

Andrew Y Koenig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 34, 38, 62, 87, 108, 119, and 127 have been considered but are moot in view of the new ground(s) of rejection.
2. The examiner errantly placed claims 128-129 along with the rejection of the Internet Service Provider over 35 USC § 112. The rejection for claim 128 has been withdrawn and a new rejection for claim 129 has been made. The examiner regrets any inconvenience. There is no antecedence for a "first-run movie" in the parent applications.
3. Claims 81-82 and 117-118 recite alternate programming such as an online address and data services. The applicant argues that "one skilled in the art at the time the application was filed would understand that Prodigy and American On-Line constituted alternate programming including an online address, as recited in claims 81-82, and on line services and data services, as recited in claims 117-118." The examiner disagrees that Prodigy and American On-Line constitute an online address and the applicant has provided no evidence supporting their position. However, due to the broad scope of on line services and online address, the examiner has withdrawn the rejection.

### ***Priority***

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

5. This application repeats a substantial portion of prior Application No. 08/912,934, filed 15 August 1997 and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

***Allowable Subject Matter***

6. Claims 1-18, 20, 23-29, 34-35, 38-90, 93-96, 101-111, 116-121, 124-125, and 127-129 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

8. Regarding independent claims 1, 34, 38, 62, 87, 108, 119, and 127, prior art of record fails to show or fairly suggest using a heuristic in the operations center to automatically generate menus, where heuristic is defined by Webster's as: "involving or

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serving as an aid to learning, discovery, or problem-solving by experimental and esp. trial-and-error methods."

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 34, 38, 62, 87, 108, 119, and 127 of the instant application are being allowed for the same patented limitation as shown in Hendricks '548.

11. Claims 1, 38, 62, 108, 119, and 127 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,539,548 to Hendricks et al. (hereinafter Hendricks '548) in view of U.S. Patent 5,477,262 to Banker et al. in view of U.S. Patent 5,479,266 to Young et al.

12. Claims 1, 38, 62, 108, 119, and 127 of the instant application corresponds to claim 1 of the Hendricks '548. But claims 1, 34, 38, 62, 87, 108, 119, and 127 of the instant application add the limitations of the terminals, which is an obvious variation as shown by the prior art.

Allowing claims from the instant application would create an unwarranted timewise extension.

Claims of the instant invention are directed to the menu generation, transmission, including receiving, displaying, and controlling the menu. Hendricks '548 teaches the menu generation and transmission of the signals (while having the same patentable limitation as indicated in the allowable subject matter during prosecution). Claims directed to the menu generation and transmission as indicated in Hendricks '548 are an obvious variation to those of the instant application, which recite additional limitations directed to receiving, displaying, and controlling the menu.

Banker teaches packaging programs and distributing them, where the packaging includes at least one program (col. 8, ll. 45-60), generating and providing menu information (col. 13, ll. 35-61; fig. 7-20), by means of menu screens, on-screen displays (OSDs), and messages. Banker teaches a terminal that stores menu information (col. 9, ll. 42-51), displays menu information (fig. 7-20), choosing a program from the displayed menu (fig. 13A, screens 32b and 32c), receiving the program, but is silent on switching. Young teaches choosing a program from a displayed menu, receiving the program, and switching the terminal (col. 7, ll. 24-27). Banker teaches menus related to a pay-per-view service (see fig. 6E, 6F, 12, 13a, 13b), which reads on the broadest reasonable interpretation of interactive service and a data services. Furthermore, Banker teaches transmitting the menu data for the interactive services and data services to the user (col. 8, ll. 45-60). Banker is silent on scrolling. Young teaches scrolling (col. 2-3, ll. 55-14), which allows the menu to exceed the size of the display.

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13. Claims 34 and 87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,539,548 to Hendricks et al. (hereinafter Hendricks '548) in view of U.S. Patent 5,477,262 to Banker et al., U.S. Patent 5,479,266 to Young et al., and U.S. Patent 5,367,330 to Haave et al.

Allowing claims from the instant application would create an unwarranted timewise extension.

Regarding claims 34 and 87, Young teaches program name, start time, duration (figs. 1-4), and a category (figs. 14-17), but is silent on setting a price. Haave teaches setting a price (col. 11, ll. 13-18). The additional limitations have been discussed above.

### ***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 19, 21-22, 30-33, 36, 37, 91, 92, 97-100, 112-115, 122, 123, and 126 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Regarding claims 21-22, 36 and 123, these claims recite the limitation of an internet service provider or "ISP". There is no antecedence in application serial number

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08/160,282 (the parent application to the instant case) for the term "ISP". The parent application does disclose both Prodigy and AOL.

17. Applicant sets forth the argument that "one skilled in the art at the time the invention was filed would appreciate that both Prodigy and America-On-Line constituted Internet Service Providers". Applicant has chosen to claim "ISP" instead of Prodigy or AOL and it is noted that this term is necessarily different than the direct support found in the 12/2/93 parent application. Furthermore, there is no evidence that the later used term "ISP" was directly conveyed in the parent application disclosure. There also has been no evidence presented that either Prodigy or AOL were "internet service providers" at the time that the 12/2/93 application was filed. Therefore, the effective filing date for claims in the instant application which recite "ISP" is the filing date of the instant application (11/16/98) and art will be applied to these claims consistent with this date.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Regarding claims 19, 21-22, 30-33, 36, 37, 91-92, 97-100, 112-115, 122, 123, and 126, the parent application fails to support the limitations addressed these claims. Accordingly, the effective date of the claims is 3 November 1998.



20. Claims 21-22, 30-33, 36, 112-115, 122, 123, and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al. U.S. in view of Patent 5,479,266 to Young et al., U.S. Patent 5,659,350 to Hendricks et al., and U.S. Patent 6,025,737 to Matthews, III et al.

Regarding claims 21-22, 36, and 123, Banker and Young are silent on accessing an Internet Service Provider (ISP) by selecting from a menu using a go button. Matthews teaches selecting an ISP (fig. 3, lab 86) from a menu (fig. 5, 7), which inherently uses a button in order to select. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by selecting an ISP from a menu as taught by Matthews in order to receive addition information.

In addition, claims 1, 62, 108, 109, 119, and 127 are taught. Banker teaches packaging programs and distributing them, where the packaging includes at least one program (col. 8, ll. 45-60), generating and providing menu information (col. 13, ll. 35-61; fig. 7-20), by means of menu screens, on-screen displays (OSDs), and messages. Banker teaches a terminal that stores menu information (col. 9, ll. 42-51), displays menu information (fig. 7-20), choosing a program from the displayed menu (fig. 13A, screens 32b and 32c), receiving the program, but is silent on switching. Young teaches choosing a program from a displayed menu, receiving the program, and switching the terminal (col. 7, ll. 24-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using a displaying a

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menu, receiving the program, and switching as taught by Young in order to conveniently display and select programs to the user. Banker teaches menus related to a pay-per-view service (see fig. 6E, 6F, 12, 13a, 13b), which reads on the broadest reasonable interpretation of interactive service and a data services. Banker teaches pay-pay-view programming (figs. 13a, 13b) which reads on specialty channel subscription.

Furthermore, Banker teaches transmitting the menu data for the interactive services and data services to the user (col. 8, ll. 45-60). Banker is silent on menu information generated automatically by analyzing the programming packaging using a heuristic. However, this limitation is taught by Hendricks (col. 15, ll. 51-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using heuristics as taught by Hendricks in order to accurately create menus for the users thereby making the menus more efficient.

Regarding claims 30-33, 112-115, 122, and 126, Banker is silent on teaches monthly and annual, first-run movie channel, sporting, full season and partial season, or favorite team subscription. Official Notice is taken that these different revenue models are old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by using these subscription techniques in order to encourage viewers to watch shows that interest them and generate revenue for the supplier.

21. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al. U.S. Patent 5,479,266 to Young et al. in view of U.S. Patent 5,940,073 to Klosterman et al.

Regarding claim 19, Banker and Young are silent on displaying an advertisement prior to the display of the chosen program. Klosterman teaches displaying an advertisement in the menu prior to displaying the chosen program (fig. 2a). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by displaying ads in the menu prior to displaying the chosen menu in order to help ensure that advertisements are viewed. See also the discussion of claim 1 above and the following. Banker is silent on the programming menu including a video window. Young teaches the use of a video window in the programming menu (see figures 9-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by providing a video window as taught by Young in order to uninterrupted viewing of a program while browsing through the programming menus.

22. Claims 37, 91, 92, 97-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al. and U.S. Patent 5,479,266 to Young et al. in view of U.S. Patent 5,367,330 to Haave et al.

Regarding claim 37, the parent application fails to support the limitations addressed this claims. Accordingly, the effective date of the claims is 3 November 1998.

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Banker is silent on programs targeted to a viewer based on demographic information. Official Notice is taken that program targeting to a viewer based on demographic information are notoriously old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by displaying programming targeted to a viewer based on demographic information in order to target the audience, which increases its effectiveness. Claim 37 depends on claim 35, Banker teaches a headend controller performing continuous refreshes interactive services and data (col. 8, ll. 28-35); clearly the system of Banker collects the information in order to send for transmission. Banker teaches a displaying authorized pay-per-view events (see fig. 13A, screen 32b), additionally, Banker teaches a database in the billing computer (col. 7, ll. 60-63) which reads on inventorying the interactive and data services to be made available to the viewer. Banker teaches a system control computer that configures tuning frequencies of the channels provided to the subscribers, which includes pay-per-view, which reads on interactive and data services. Banker displaying menu data for interactive services and data services (see fig. 13A), clearly the system of Banker must create menu data in order to format the data and send it downstream to the viewer. As per the discussion of claim 35, the examiner could not determine a reasonable interpretation of the limitation "determining a method of upstream transmissions for the interactive and data services" and accordingly no art rejection for that specific limitation can be made. Further, Claim 34 depends from claim 34, Young teaches program name, start time, duration (figs. 1-4), and a category (figs. 14-17). Haave teaches setting a price (col. 11, ll. 13-18).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker by setting a price for programs as taught by Haave in order to provide information for pay-per view services to the user and enable them to purchase the service.

Regarding claims 97-100, see discussion of claims 30-33, 112-115, 122, and 126.

Regarding claims 91-92, Banker and Young are silent on using a cable modem or wireless modem. Official Notice is taken that using a wireless modem and a cable modem are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Young by using a wireless and cable modem in order to receive information from a plurality of sources; thereby providing information to the user.

### ***Conclusion***

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

ayk  
April 5, 2003

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600